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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/166,625	10/05/1998	DAVID C. MAY	1020-0501	9351

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BARNES & THORNBURG  
11 SOUTH MERIDIAN  
INDIANAPOLIS, IN 46204

EXAMINER
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JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Letter Vacating Office Action

1. As correctly pointed out by Applicant in the letter dated June 25, 2004, any reopening of prosecution after an appeal brief is filed, must be approved by the Supervisory Patent Examiner.

As such, I concur that the action mailed June 18, 2004 failed to have supervisory approval.

Therefore, that Office action is hereby **Vacated**. A new action with proper authority will be provided in due course.

2. In the instant case, the reason for the reopening of prosecution was based on the fact that during preparation for appeal conference, the rejection of claims 9 and 17 was found to be erroneous. However, as these claims were not deemed necessarily allowable, a new Office action would be required. The new Office action will include a thorough explanation for the reopening and the changes to the grounds of rejection.

3. In addition to the issue of authority to take action, Applicant requests the supervisor to review certain issues pertaining to the application of prior art. Particularly, the allegation of inoperability of the reference to Garland is requested to be reviewed. Initially, it is noted that MPEP 716.07 is directed to the inoperability of references. *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994), mentioned at this section of the MPEP, appears to indicate that if one skilled in the art would have known how to implement the features of the references, even if an error in the disclosure is present, the reference is still enabling. In the instant case, it appears that the Examiner has provided reasoning and evidence that indicates one skilled in the art is sufficiently knowledgeable to (a) recognize the error and (b) compensate so as to practice the invention intended in the reference.

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